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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------------|------------------------|
| 10/635,044 | 08/05/2003 | Ryuta Sekine | 16894 | 6986 |
| 23389 7590 05/18/2007 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530 | | | EXAMINER SMITH, PHILIP ROBERT | |
| | | | ART UNIT 3739 | PAPER NUMBER |
| | | | MAIL DATE 05/18/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/635,044 | SEKINE ET AL. | |
| | Examiner | Art Unit | |
| | Philip R. Smith | 3739 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-15, 17-19, 21-29 and 31-41 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3, 5, 31-34 and 36 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 41 is/are allowed.
- 6) ☒ Claim(s) 1, 6, 8-14, 17, 18, 35 and 38 is/are rejected.
- 7) ☒ Claim(s) 15, 19, 21-29, 37, 39 and 40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action, or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

- [01] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [02] Claims 1,6,8-14,17-19,35,38 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams et al. (U.S. Patent No. 6,119,913).
- [03] In regard to claims 1, 6, 8, 9, 12-14, 17-19, 35 and 38, Adams et al. teach an endoscopic stapler 10 comprised of a stapling head 12 with an attached sleeve 14 for attaching the stapler 10 to a conventional endoscope 16 (see Figure 1). The endoscope 16 has optical paths 16 and 16c and instrument lumens 16b and 16d (see Figures 1 and 1a). A forceps instrument 26 may be inserted through a lumen 916b) of the endoscope 16 into the space between a stationary part 18 and a movable part 20 of the stapler 10 in order to pull tissue into the stapler (see col. 6, lines 53-60). The stapling head 12 includes a removable staple cartridge 30 and a cutting knife 42 is coupled to a cam 36 (see Figure 1). In operation, the stapler 10 is attached to the endoscope 16, the assembly is advanced to the surgical site and the forceps 26 are inserted through the instrument port and used to draw diseased tissue into the space between the movable part 20 and the stationary part 18. When the movable part 20 and stationary part 18 are tightly closed, a control wire 22 is rotated to fire staples 32 around the diseased tissue and to sever the diseased tissue from the stapled tissue with the knife 42 (see col. 8, lines 1-25). In regard to claims 10 and 11, see Adams et al. teach the use of a side viewing

endoscope 116 (see col. 8, lines 40-50 and Figure 8).

Allowable Subject Matter

[04] Claims 4,41 are allowed.

[05] Claims 15,19,21-29,37,39,40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

[06] Applicant's arguments filed 3/15/2007 have been fully considered but they are not persuasive.

[07] Applicant contends that "[a]lthough the endoscope disclosed by Adams can be articulated in the direction of the space, the threaded post (352) (see Figures 9 and 9A) prevents it from doing so." It is maintained that Adams discloses a second insertion instrument configured such that a first insertion instrument can be bent in the space to a side opposite to the living tissue that is the object of the treatment. The threaded post "352" does not prevent "endoscope 16" from bending in a downward (with reference to Figure 9A) direction.

[08] Although it is possible that "352" limits the degree to which "16" may be bent, it does not "prevent it from doing so," as Applicant argues. If it is conceded that "352" limits the degree to which "endoscope 16" can be articulated downward, Adams still anticipates the claims, which functionally recite that a "first insertion instrument" can be bent "to a side opposite to the living tissue that is the object of

treatment.” Applicant argues that “352” completely prevents downward articulation which, as shown in Figure 9A, is clearly not the case. Limited downward articulation anticipates the recited bending.

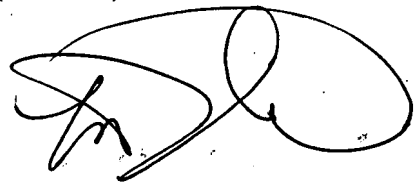

- [09] Secondly, it appears from Figure 12A, a top-down view, that the posts which support the stapling mechanism are offset, in which case they do not limit the downward articulation of the first insertion instrument at all.
- [10] Thirdly, if it is conceded that “352” does completely prevent downward articulation, it is noted that “352” may anticipate a “side opposite to the living tissue that is the object of treatment,” in which case Adams once again anticipates the functional recitations of the claims, wherein “16” bends “to a side opposite” (threaded post “352”).

Conclusion

- [11] **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
- [12] A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the date of this final action.

- [13] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [14] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.
- [15] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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